

07/824,287 01/23/92



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
FISH & RICHARDSON 601 THIRTEENTH ST., N.W. WASHINGTON, DC 20005		WATKINS	111

EXAMINER
1508

ART UNIT	PAPER NUMBER
	4

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|-------------------------------------------------------------------------------------|---------------------------------------------------------------------------------|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-23 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-23 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

15.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-11, drawn to a water repellant film on a rough surface, classified in Class 428, subclass 141.

II. Claims 12-21, drawn to a method of coating a water repellant film on a rough surface, classified in Class 427, subclass 407.1.

III. Claims 22-23, drawn to a method of coating a water repellant film with particles on a surface, classified in Class 427, subclass 180.

16.

The inventions are distinct, each from the other because of the following reasons:

Inventions Groups II and III; and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product as claimed can be made by either of the materially different processes of Group II or Group III

Group II and Group III are separate and distinct each group

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having an order of process steps which is incompatible with the other group. No generic claim links the two groups.

17.

Because these inventions are distinct for the reasons given above and since these distinct inventions have acquired a separate status in the art, as shown by the above classification, and since the fields of search are not co-extensive, restriction for examination purposes as indicated is proper.

18.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

19.

A telephone call was made to Mr. Richard Jordan on Sept. 11, 1992 to request an oral election to the above restriction requirement, but did not result in an election being made.

Mr. Jordan was on vacation.

20.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition

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under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

21.

Crystal Mall 1 Fax Center

A facsimile center has been established in Crystal Mall 1, room 10D08. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 308-4227. This new location should be used in all instances when faxing any correspondence to Group 150. The existing facsimile center for the Patent Examining Corps can be used as a backup if you are unable to reach the Crystal Mall 1 center. The existing Patent Examining Fax Center telecopier numbers are (703) 308-3718 and (703) 308-3721. Use of the new Crystal Mall 1 center will facilitate rapid delivery of materials to the Group. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989).

22.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is (703) 308-2420.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

W. P. Watkins III
W. Watkins:tj
September 18, 1992

Ellis P. Robinson
ELLIS P. ROBINSON
SUPERVISORY PATENT EXAMINER
ART UNIT 158